

REMARKS**Summary of the Office Action**

Claims 1, 3-4 and 6-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Caracci et al. (U.S. Patent No. 6,571,033) (hereinafter “Caracci”).

Claims 2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Caracci.

Summary of the Response to the Office Action

Applicants have amended independent claim 1 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Claims 6 and 7 have been canceled without prejudice or disclaimer. As a result, the dependence of claim 8 has been amended to be dependent on newly-amended independent claim 1. Accordingly, claims 1-5 and 8-10 are currently pending for consideration.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1, 3-4 and 6-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Caracci. Claims 2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Caracci. Applicants have amended independent claim 1 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. To the extent that these rejections might be deemed to still apply to

the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants have newly-amended independent claim 1 of the instant application to describe a combination of features of an optical transmitting and receiving module including the following advantageous features, for example: (1) the first lens for guiding the light emitted from the laser diode to the dielectric film filter is provided in a groove formed in a first main surface of the light transmitting substrate and between the laser diode and the dielectric film filter, and the second lens for guiding the light passing through the dielectric film filter and having the second wavelength to the optical input/output portion, is provided in a groove formed in the first main surface of the light transmitting surface; (2) the photodiode is mounted on a second surface of the light transmitting substrate surface which is opposed to the first surface through the light transmitting substrate; and (3) a converging lens is formed on the first main surface of the light transmitting substrate for guiding light reflected from the dielectric film filter to a photodiode.

Applicants respectfully submit that the invention described in newly-amended independent claim 1 of the instant application is directed to an optical transmitting/receiving module using a light transmitting substrate. In this module, each of a laser diode, a dielectric film filter, an input/output portion, and lenses for optically connecting between the laser diode and the dielectric film filter, and also between the input/output portion and the dielectric film filter, are provided on one side of the light transmitting substrate. In addition, a converging lens is formed on a surface of that one

side of the substrate for converging a light reflected by the dielectric film filter on a photo diode provided at the other side of the light transmitting substrate through the light transmitting substrate. Further, Applicants respectfully submit that the lenses, the dielectric film filter, and the input/output portions are set in grooves formed in the one side of the substrate.

Accordingly, Applicants respectfully submit that, in the module described in the advantageous combination of features of newly-amended independent claim 1, the arrangement of the dielectric film filter, the input/output portion, and the lenses provided therebetween result in easy, high accuracy, performance that results from the placement of these optical elements on the same side of the light transmitting substrate and also set in the grooves formed on the same side of the light transmitting substrate.

Additionally, Applicants respectfully submit that the converging lens for converging the light on the photo diode is also formed on the surface on which these optical devices are located, and all of the optical elements inserted between the input/output portion and the laser diode and also between the input/output portion and the photo diode are advantageously arranged on the one side of the substrate. Further, because the grooves for the lenses and the dielectric film filter and the converging lens are formed in that same one side of the light transmitting substrate, the arrangements of the optical devices and lenses in the module according to newly-amended independent claim 1 are able to perform easily and with high accuracy.

On the contrary, Applicants respectfully submit that Caracci discloses in Fig. 5 that a transparent mounting structure 92 of optical transceiver 90 has an LD 26, a prism

102 on which a filter 60 is provided, and alignment features 22, 100, and 14 are located at different plains, respectively. In this structure, Applicants respectfully submit that the positional relationships between the alignment features 22, 100, and 14 are stereoscopic and, as a result, it is difficult to perform the relative alignment of the alignment features with high accuracy and the like.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Caracci does not teach or suggest each feature of newly-amended independent claim 1 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Also, MPEP § 2143.03 instructs that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Furthermore, Applicants respectfully assert that the dependent claims 2-5 and 8-10 are allowable at least because of their dependence from independent claim 1 and the reasons set forth above.

CONCLUSION

In view of the foregoing, Applicants submits that the pending claims 1-5 and 8-10 are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after

consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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